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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/778,022	02/17/2004	Hans-Ulrich Vogler	2001P80113WOUS	6174

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EXAMINER

KEASEL, ERIC S

ART UNIT PAPER NUMBER

3754

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/778,022

Applicant(s)

VOGLER, HANS-ULRICH

Examiner

Eric Keasel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 7, 9, 10, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDonald (US Patent Number 4,057,217).

MacDonald discloses an arrangement for closing a through flow opening in a throttle valve connection piece comprising: a throttle valve shaft (19) positioned over and transverse to said through flow opening, said shaft pivotably mounted to said throttle valve connection piece (see Fig. 2); and a throttle valve (21) comprising a receiving opening running a length of and planar to said valve, said receiving opening comprising an interior opening (22) wherein said shaft is mounted such that said valve selectively closes said flow opening, and one or more recesses (35, 37) into said interior opening wherein said valve is connected to said shaft by at least one welding (49); wherein said valve comprises walls forming a hub, said hub comprising said receiving opening; wherein said throttle valve comprises a connecting element (41, 43) connected to said throttle valve and projecting into said recess, said connecting element comprising a material weldable to said throttle valve shaft; wherein said connecting element comprises two connecting elements (41, 43) arranged firmly connected to said throttle valve and projecting, in opposite directions to one another, tangential to said throttle valve shaft, and into

said recesses (35, 37); wherein said shaft further comprises opposing ends projecting into recesses within a housing of said throttle valve connection piece (see Fig. 2); wherein said connecting element extends, along said valve shaft, a substantial length of said recess; further comprising a plurality of connecting elements adjacently arranged within said recess and along said throttle valve shaft; wherein said throttle valve comprises a lightweight metal; and wherein said throttle valve shaft comprises steel.

3. Claims 1-4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Obermaier (US Patent Number 3,675,681).

Obermaier discloses an arrangement for closing a through flow opening in a throttle valve connection piece comprising: a throttle valve shaft (35) positioned over and transverse to said through flow opening, said shaft pivotably mounted to said throttle valve connection piece; and a throttle valve (33) comprising a receiving opening running a length of and planar to said valve, said receiving opening comprising an interior opening wherein said shaft is mounted (see Fig. 2) such that said valve selectively closes said flow opening, and one or more recesses (near 34) into said interior opening wherein said valve is connected to said shaft by at least one welding (see column 2, line 19); wherein said valve comprises walls forming a hub, said hub comprising said receiving opening; wherein said throttle valve comprises a connecting element (34) connected to said throttle valve and projecting into said recess, said connecting element comprising a material weldable to said throttle valve shaft; and wherein said connecting element is welded to said throttle valve shaft at its projection within said recess.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MacDonald.

Regarding “prestress” and the various welding methods, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

6. Claims 11, 12, and 16-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Obermaier.

Regarding “injection molding” and “encapsulation” during its manufacture, “prestress” and the various welding methods, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald.

MacDonald discloses the connecting element welded to the valve rather than the valve shaft. The examiner took official notice that such a location of the weld is an old and well-

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known expedient in the art. Since applicant did not traverse the examiner's assertion, the location of the weld being an old and well-known expedient in the art is taken to be admitted prior art.

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obermaier.

Obermaier is silent as to the material selections set forth in claims 13-15. The examiner took official notice that these material selections are old and well-known expedients in the art. Since applicant did not traverse the examiner's assertion, the material selections set forth in claims 13-15 being old and well-known expedients in the art is taken to be admitted prior art.

Response to Arguments

9. Applicant's arguments filed October 6, 2004 have been fully considered but they are not persuasive.

Applicant argues that the recesses of MacDonald extend completely through the throttle valve and do not expose the shaft. The examiner agrees with the first portion of the statement but disagrees with the second portion of the statement. The recesses of MacDonald clearly intersect the receiving opening. More importantly, there is no recited claim limitation that matches applicant's statement regarding any perceived differences between the disclosure of MacDonald and claim 1.

Applicant argues that there is no direct welding of the shaft to the valve in MacDonald. However, it should be noted that the disclosure of applicant does not have the shaft directly welded to the valve either (as intermediate piece is required). This is why the claim recitation broadly recited that "said valve is connected to said shaft by at least one welding". This must be

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read as the weld directly connects intermediate parts in the connection of the valve to the shaft.

MacDonald clearly meets this recitation.

Applicant argues that claim 3 requires that the connecting element is welded to the shaft. The examiner disagrees. The claim limitation requires that the material is weldable (i.e. capable of being welded) to the shaft. The connecting element of MacDonald is made of a material that is capable of being welded to the shaft.

Re claims 6 and 10, applicant argues that the claim limitation requires multiple connecting elements in a single recess. The examiner disagrees. Applicant has recited “one or more recesses” in the claims and also “said recess”. This inconsistency in terminology causes some confusion, but it would appear that “said recess” refers to (and is used interchangeably with) the previously recited “one or more” recesses.

Applicant argues that the large recess in the valve of Obermaier can not be read as the receiving opening for the shaft. The examiner disagrees. The broadly recited “receiving opening” does not require that the shaft be inserted into a round hole.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Keasel 4 FEB 2005

Eric Keasel
Primary Examiner
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